

REMARKS

I. Status of the Claims

Claims 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are now pending. Further to the Restriction Requirement dated September 28, 2007, claims 80-84 are withdrawn from consideration as being drawn to nonelected subject matter. No amendments are provided herein. Accordingly, no new matter has been added.

II. Restriction Requirement and Election of Species

Applicants respectfully acknowledge that the "election of [G]roup I...has been treated as an election without traverse." Office Action at page 2. However, Applicants respectfully remind the Examiner, if the elected species within Group I are found allowable, of her duty to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a "reasonable" number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

The Examiner also states that claims 32 and 37 are withdrawn from consideration "as being drawn to a nonelected species." Office Action at page 3. Applicants respectfully disagree. Claims 32 and 37 limit the at least one polymer chosen from cationic and amphoteric polymers of claim 1 to various cationic species including polyalkyleneimines. As such, both claims 32 and 37 encompass the elected species, polyethyleneimine. Thus, Applicants respectfully submit that claims 32 and 37 are drawn to the elected species and should be examined.

III. Priority

Applicants claim the benefit of U.S. Provisional Application No. 60/454,620 filed March 17, 2003, as indicated in paragraph [001] of the present application. The Examiner states that in order to claim the benefit of the U.S. Provisional Application No. 60/454,620, a certified English translation of the provisional application must be submitted. See Office Action at pages 3-4. In accordance with the Examiner's request, a certified English translation has been filed in the U.S. Provisional Application No. 60/454,620 on March 24, 2008. A copy of the filing receipt is submitted herewith confirming the filing of a certified English translation in the U.S. Provisional Application No. 60/454,620.

IV. Rejection under 35 U.S.C. § 103

(a) Rejection based on Commonly Owned Patents and/or Applications

The Examiner rejects claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,258,852 (the '852 patent) or U.S. Patent Application Publication Nos. 2003/0108503 (the '503 publication) or 2003/0103927 (the '927 publication) or 2004/0001796 (the '796 publication) or 2003/0103929 (the '929 publication) alone or in combination with U.S. Patent Application Publication Nos. 2004/0197356 (the '356 publication) or 2004/0197355 (the '355 publication) for the reasons set forth in the Office Action at pages 5-8.

Applicants have perfected their claim of priority to U.S. Provisional Application No. 60/454,620 by filing a certified English translation in that application. As such,

Applicants are entitled to a U.S. effective filing date of March 17, 2003. The '852 patent, the '503 publication, the '927 publication, the '796 publication, and the '929 publication are prior art only under 35 U.S.C. § 102(e) as indicated by the Examiner. See Office Action at page 5.

In accordance with 35 U.S.C. § 103(c)(1), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicants herein certify that the '852 patent, the '503 publication, the '927 publication, the '796 publication, and the '929 publication were commonly assigned to L'Oréal S.A. at the time of invention of the present application. The present application is assigned to L'Oréal S.A., as recorded on July 28, 2004 at Reel 015625, Frame 0721. The '852 patent is assigned to L'Oréal S.A., as record on December 10, 2002, at Reel 013567, Frame 0428. The '503 publication is assigned to L'Oréal S.A., as recorded on December 9, 2002, at Reel 013556, Frame 0790. The '927 publication is assigned to L'Oréal S.A., as recorded on December 10, 2002, at Reel 013567, Frame 0430. The '796 publication is assigned to L'Oréal S.A., as recorded on December 10, 2002, at Reel 013568, Frame 0452. Finally, the '929 publication is assigned to L'Oréal S.A., as recorded on December 9, 2002, at Reel 013620, Frame 0096. Accordingly, Applicants respectfully submit that the rejections based on the '852 patent, the '503 publication, the

'927 publication, the '796 publication, and the '929 publication are improper, and should be withdrawn.

(b) Rejection based on Non-L'Oréal Patents and/or Publications

The Examiner rejects claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Nos. 6,635,702 (the '702 patent) and 5,580,494 (the '494 patent), as well as WO 2002/096385 (WO '385) and WO 2002/096377 (WO '377) for the reasons set forth in the Office Action at pages 8-11. Applicants respectfully disagree.

The Examiner alleges that the '702 patent teaches aqueous surfactant compositions using at least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-4 alkyl acrylate unit (as a rheology modifier). See Office Action at page 9. The Examiner also contends that the '702 patent teaches silicone, surfactants, and one agent being beneficial to keratin materials. See *id.* The Examiner further asserts that the '702 patent suggests adding insoluble compounds, including calcium carbonate, as well as cationic conditioning polymers. See *id.* The Examiner concedes that the '702 patent does not teach the elected species, the cationic polymer polyethyleneimine or at least 10% by weight of calcium carbonate. See *id.*

The Examiner contends that the '494 patent teaches shampoo compositions using polyethyleneimine with surfactants. See *id.* The Examiner further claims that the '494 patent "suggests adding thickeners also known as rheology modifiers." *Id.* at page 10. The Examiner also alleges that WO '385 and WO '377 "teach using 10% of calcium carbonate in cosmetic compositions and using these compositions for hair." *Id.*

Finally, the Examiner states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of [the ‘702 patent] and add calcium carbonate and polyethyleneimine (cationic polymer) expecting beneficial effect to the hair.” *Id.* The Examiner claims that one “would be motivated to add the cationic polymer and panthenol into the compositions of [the ‘702 patent] expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased [sic] or decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethyleneimine into the compositions provide the a [sic] conditioning effects which is excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair.” *Id.* at pages 10-11. Applicants believe that the Examiner is arguing that the ‘702 patent teaches all the elements of the present claims and the ‘494 patent, WO ‘385, and WO ‘377 merely teach the elected species. Applicants respectfully disagree and traverse for at least the following reasons.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (8th ed. Sept. 2007 Rev.) (emphasis in original) (citations omitted). The ‘702 patent only broadly discloses, in a laundry list of possible ingredients, cationic polymers which “can optionally be utilized.” The ‘702 patent at col. 11, lines 36-53 (emphasis added). Additionally, insoluble calcium carbonate is just one of many ingredients listed under “other insoluble compounds.” *Id.* at col. 8, lines 54-67.

The '702 patent provides no direction as to why or how one skilled in the art would selectively choose cationic polymers or calcium carbonate over other ingredients.

Further, an examiner must "[c]onsider any teachings of a 'typical,' 'preferred,' or 'optimum' species or subgenus within the disclosed genus." M.P.E.P. § 2144.08. That analysis necessarily includes those exemplified compositions that are dissimilar from those presently claimed: "[s]uch a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness." M.P.E.P. § 2144.08 (citing *Baird* 16 F.3d 380, 382 (Fed. Cir. 1994)). In this case, none of the seventeen Examples in the '702 patent contain at least one water-insoluble solid mineral particle chosen from clays, particles comprising alumina, particles comprising at least 10% by weight of calcium carbonate, and selenium sulphide, as required by the present claims. Further, the Examiner has provided no reason "to select the claimed species or subgenus from the disclosed prior art genus" in the '702 patent. M.P.E.P. § 2144.08.

Additionally, under *KSR*, an "obvious to try" rationale for prima facie obviousness can only be supported when there is a "finite number of identified, predictable potential solutions to the recognized need or problem." M.P.E.P. §2143(E). Even a layperson, and certainly one of ordinary skill in the art, knows that personal care products vary widely in terms of formulation of ingredients depending on the desired use, texture, appearance, etc., and that not all ingredients will be compatible. The possible ingredients in hair compositions generally, cannot be considered "finite" the way the term was used in *KSR* to describe the location of a sensor on a pedal. See, e.g., 82 USPQ2d at 1397.

Further, one would not attempt to simply modify an optional cationic polymer or the amount of an optional insoluble compound listed in the '702 patent with specific groups taught in the '494 patent, WO '385, and WO '377, as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

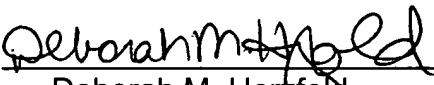
If the Examiner believes a phone call would be useful in resolving the outstanding issues, she is respectfully invited to contact the undersigned at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 31, 2008

By: 
Deborah M. Herzfeld
Reg. No. 52,211

Attachments: Copy of the transmittal filing the certified English translation in the U.S. Provisional Application No. 60/454,620 on March 24, 2008.